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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/025,155

12/18/2001

William Emil Heinz

85085

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78639

7590

05/05/2010

HBS WELSH & KATZ - COMMScope, INC.
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EXAMINER

PHAN, DAO LINDA

ART UNIT

PAPER NUMBER

3662

MAIL DATE

DELIVERY MODE

05/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/025,155	Applicant(s) HEINZ ET AL.	
	Examiner Dao L. Phan	Art Unit 3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-45, 47-56 and 58-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-45 is/are allowed.
- 6) ☒ Claim(s) 47 and 54-56 is/are rejected.
- 7) ☒ Claim(s) 48-53 and 58-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's arguments filed on 11/05/2009 have been fully considered but they are not persuasive.
2. Applicant's arguments on p.2 are not convincing. Applicant can use 120 priority applications to avoid 135(b) rejection, but the subject matter that is the focus of the 135(b) claims must be claimed and not just disclosed in the priority U.S. applications. 120 is for US priority only. It is not for any PCT or NZ applications.
3. On p. 2, applicant argues that "Therefore, pursuant to 35 U.S.C. §120 and *Ryan*, the captioned application has an effective filing date of 16 October 1995 for all purposes, including avoiding a §135(b) (2) bar". This argument is not convincing. It is not for all purposes. It does not avoid a §135(b) (2) bar.
4. Applicant has 9 counts listed in the attachment A. It is not clear where many of these counts came from or which claims they are identical to. Because the counts must be patentable, they generally are from the application/patent claims. If the applicant wants different counts from what has been claimed, normally the claims will be formally added to the application in order that their patentability can be determined. Each count must also be patentably distinct (capable of supporting a separate patent (non-obvious over each other, with or without modifying prior art)) from each other. It is rare to have more than a count or two since multiple patentably distinct inventions would have been presumably restricted out.

It is not clear how each of the count claims differ from one another to make them patentably distinct, and why each count is patentably distinct from the others.

If there is more than one count, i.e., patentably distinguishable inventions, explanations must also be given for each of the claims (pending and patented) which correspond to the additional count. If there are more than one count, applicant further needs to show, for the claims which do not correspond to the count, how these claims patentably distinguish from the count.

5. With regard to the attachment B, all of the patent and application claims need to be indicated as whether or not they correspond to each of the counts. It appears that many of the counts are not listing claim correspond for all of the claims.

6. With regard to the attachment D, the captioned application (and in all of its ancestor applications going back to the corresponding international application PCT/NZ95/00106) and in foreign priority application NZ 272778 have no bearing on the earliest effective US filing date.

7. Claims 47, 54-56 are rejected under 35 U.S.C. 135(b) (2) as the claims must be present or copied within one year from the issue date or the publication date.

Application No. 09/817,268 became Patent no. 6,677,896 was published on 10/25/2001, the one year requirement runs from that date.

Claim 47 was copied from claim 6 (including the claim 1 features on which it depends) of Publication of appl. 09/817,268.

Claim 54 was copied from claim 13 of Publication of appl. 09/817,268.

Claim 55 was copied from claim 14 of Publication of appl. 09/817,268.

Claim 56 was copied from claim 15 of Publication of appl. 09/817,268.

There are no material differences respectively between claims 47, 54-56 of currently pending claims and claims 6, 13-15 of PG PUB US 2001/0033247.

8. The request for an interference with two patents is objected to as not complying with 37 CFR 41.202 (a) (2)-(3) and MPEP 2304.02(b). Applicant failed to show how the claims of the instant application and of the patents correspond to one or more counts and why the claims interfere. This showing needs to:

- a. identify one claim (typically the broadest), which is the "count", for each invention that is patentably distinct and is believed to be part of the interference. If it is applicant's intent to have only one count, the request for interference should be amended to clearly state this point and delete references to alternative claims which were listed with the use of "or" in the sheet entitled PROPOSED COUNT FOR HEINZ filed April 20, 2004. Applicant should also state what claim is the count; for example pending claim 1.
- b. for each claim (pending claims and patented claims) which corresponds to the count(s), explain why the claim is not patentably distinguishable from the "count(s)", and for each claim which does not correspond to the count, explain why the claim is patentably distinguishable from each of the count(s).

For example, for a first claim, the explanation could be a statement that the first pending claim is identical in scope to the count.

For a second claim which is an obvious variation of the invention of the count, the explanation could be identifying the claimed feature(s) which differ between the second pending claim and the count, and then stating why the difference is obvious.

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If there is more than one count, i.e., patentably distinguishable inventions, explanations must also be given for each of the claims (pending and patented) which correspond to the additional count. If there are more than one count, applicant further needs to show, for the claims which do not correspond to the count, how these claims patentably distinguish from the count.

9. The request for an interference with two patents is objected to as not complying with 37 CFR 41.202 (a) (6).

Applicant failed to provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter for each constructive reduction to practice for which the applicant wishes to be accorded benefit.

See 37 CFR 41.202(a)(6) and MPEP § 2304.02(c).

10. Claims 48-53, 58-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 22-45 are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dao L. Phan whose telephone number is (571)272-6976. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dao L. Phan/
Primary Examiner, Art Unit 3662